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Docket No. 58102-DIV (71987)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: C. Huang
U.S. SERIAL NO.: 10/787,269 GROUP: 2814
FILED: February 25, 2004 EXAMINER: P. Cao
FOR: SEMICONDUCTOR PACKAGE WITH HEAT DISSIPATING
STRUCTURE

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the U.S. Patent & Trademark Office by facsimile number 571-273-8300 on December 9, 2005.

By: 

Steven M. Jensen

Commissioner for Patents
P.O. Box 1450
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Sir:

RESPONSE TO OFFICE ACTION

Applicant is in receipt of the Office Action dated September 9, 2005 of the above-referenced application. Applicant responds to the Office Action as follows.

In response to the double patenting rejection over U.S. Patent 6,720,649, Applicant has submitted herewith a Terminal Disclaimer, thereby obviating the rejection.

Claims 16-45 are pending in the application.

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Applicant's claimed invention is directed to a heat dissipating structure for a semiconductor package, including a flat portion and a plurality of support portions formed at edges of the flat portion, where a space is formed between two adjacent support portions, the space being sufficiently dimensioned to accommodate conductive elements (e.g., bonding wires) and passive components, so as to allow the bonding wires to pass through the space to reach an area on the substrate outside coverage of the heat dissipating structure, and such that the passive components are located on the substrate within and/or outside the coverage of the heat dissipating structure (see, e.g., claim 16).

Claims 16-24, 26-33, 35-41 and 43-45 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent Application Publication US 2002/0113308 to Huang et al. ("Huang") in view of "Applicant's admitted prior art" (hereinafter "AAPA"). Claims 16-45 were rejected under 35 USC 103(a) as being unpatentable over U.S. Patent 5,736,785 to Chiang et al. ("Chiang") in view of AAPA. These rejections are respectfully traversed.

It should be noted that Huang is not prior art to the subject application under 35 USC 102(e)/103.

Huang does not qualify as prior art under 35 USC 103(c), and therefore cannot be used in a rejection of claims under 35 USC 102(e)/103. The subject application and Huang have the same assignee, *Siliconware Precision Industries Co., Ltd.* of Taiwan, R.O.C., and were commonly owned at the time the invention was made.

That is, the subject application and Huang were, at the time the invention was made, owned by Siliconware Precision Industries Co., Ltd. Therefore, under MPEP 706.02(l)(2), Huang is not prior art to the subject application under 35 USC 103(c).

Moreover, Huang simply is not prior art to the subject application under any other provision of 35 USC 102. The publication date of Huang (August 22, 2002) is *later than* the domestic priority date of the subject application – August 2, 2002. The subject application was

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filed on February 25, 2004, and is a divisional of U.S. Serial No. 10/211,430, filed on August 2, 2002. Therefore, Huang has a publication date *later than* the priority date of the subject application, and thus does **not** qualify as prior art under 35 USC 102(a).

Because Huang is not prior art to the subject application, the rejection over Huang in view of "Applicant's admitted prior art" is rendered moot.

Regarding the rejection of claims 16-45 over the Chiang reference in view of AAPA, in the Office Action of 09/09/2005, it was admitted that "Chiang does not disclose a passive component mounted on the substrate" (see Office Action at page 5, 2nd paragraph).

AAPA was cited allegedly to remedy this deficiency, specifically PRIOR ART FIG. 5 and page 2, lines 11-13 of the specification.

As described in the Background of the Invention section of the specification, the prior art structure depicted in FIG. 5 includes "a receiving space 35 where internal components such as the chip 31, bonding wires 32, and passive components (not shown) are placed" (specification at page 2, lines 12-13). The receiving space 35 includes a flat portion 330 and an encircled support portion 331.

However, PRIOR ART FIG. 5 and the accompanying description merely teach that passive components are received in the receiving space 35. There is no teaching or suggestion in AAPA that the passive components can be accommodated in a space formed between two adjacent support portions of the heat dissipating structure, as recited in claims 16, 29, and 38.

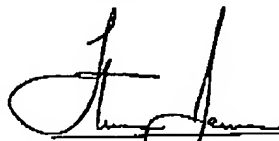
Therefore, even if AAPA were somehow combined with Chiang, the proposed combination would not teach or suggest "a space between two adjacent support portions ... sufficiently dimensioned to accommodate the conductive elements and the passive components" where "the passive components are located within and/or outside the coverage of the heat dissipating structure" (claim 16; see also claims 29 and 38).

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For at least the reasons discussed above, the proposed combination of Chiang in view of AAPA does not render obvious the Applicant's claimed invention.

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



Date: December 9, 2005

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